



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicants:** Billot, et al.

**Serial No.:** 10/797,257

**Case No.:** MC080Y

**Filed:** Filed: March 10, 2004

**For:** EP4 Receptor Agonists, Compositions and Methods  
Thereof

**Art Unit:**

1624

**Examiner:**  
Habte Kahsay

Commissioner for Patents  
Alexandria, VA 22313-1450

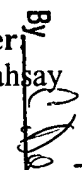
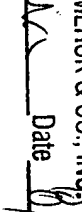
**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

This paper is filed in response to the restriction requirement mailed August 1, 2005 and for which a response is due on September 19, 2005. Claims 1-6 and 8-17 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121 as follows:

- Group I Claims 1-3 (in part), 5-6 (in part) and 8 (in part), drawn to 1,3-thiazinans (i.e.  $X=S$  and  $Y=CH_2$ ), classified in class 544, subclass 54.
- Group II Claims 1-3 (in part), 5-6 (in part) and 8 (in part), drawn to 1,3-oxazinans (i.e.  $X=O$  and  $Y=CH_2$ ), classified in class 544, subclass 88.
- Group III Claims 1-3 (in part), 5-6 (in part) and 8 (in part), drawn to 1,3-thiazinans (i.e.  $X=$  and  $Y=CH_2$ ), classified in class 546, subclass 243.
- Group IV Claims 1-3 (in part), 5-6 (in part) and 8 (in part), drawn to 1,3-thiazinans (i.e.  $Y=O$  and  $X=CH_2$ ,  $Y=S$  and  $X=CH_2$ ), classified in class 544, subclass 59.
- Group V Claims 10-11 drawn to complex composition, classified in class 514, subclass various.
- Group VI Claims 12-17 drawn to a method of treatment, classified in class 514, subclass various.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

By  Date  8/29/05

MERCK & CO., INC.

Applicants provisionally elect the invention of Group II (Claims 1-3 (in part), 5-6 (in part) and 8 (in part), drawn to 1,3-oxazinans (i.e.  $X=O$  and  $Y=CH_2$ )) with traverse. Applicants respectfully assert that the Examiner fails to justify the restriction requirement because contrary to the Examiners' assertion, the present invention of Groups I-II, and IV-VI are related.

35 U.S.C. 121 specifies that if two or more independent and/or distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. See MPEP 802.01. Independent generally means that there is no disclosed relationship between the two or more claimed inventions. "Distinct" means that the inventions, although related, are capable of separate use and patentably distinguishable.

The Examiner based the restriction on the ground that the present inventions are unrelated because in the instant case, the different inventions have various hetero groups. On the contrary, the present invention is closely related in structure and use as agonist of the EP<sub>4</sub> receptor. Although the variation exists in the X and Y substituents of the piperidino group, the X and Y substituents are closely related hetero groups because the compounds containing these hetero groups are all drawn to the compounds of EP<sub>4</sub> agonists and can be used to treat a subject suffering from ocular diseases such as glaucoma and ocular hypertension. Furthermore, even though only one invention may be claimed in a single application, a reasonable number of species of the invention can be claimed if there is an allowable generic claim in the application, which is the case of the present application. Accordingly, there is no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Moreover, as the Examiner noted in the restriction, the groups are related: for example Groups I, II and IV are related since they fall under the same classification, class 544.

Regarding the method of use and composition claims, the Examiner can access information regarding these claims while searching for the compound themselves. Thus, there is minimal burden on the Examiner to examine Groups I, II, and IV-VI.

In view of the above, the Examiner is respectfully requested to withdraw the restriction requirement of Groups I, II and IV and VI.

The Examiner is respectfully requested to contact the undersigned attorney on any matter related to this application.

Respectfully submitted,

By: 

Sylvia A. Ayler

Registration No. 36,436

Attorney for Applicants

Merck & Co., Inc.

P.O. Box 2000 - RY 60-30

Rahway, New Jersey 07065-0907

Telephone No. (732) 594-4909

Date: August 29, 2005